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In re application of	:	
Joe Sorn	:	DECISION ON
Serial No. 09/750,990	:	PETITION
Filed: December 28, 2000	:	
For: FOODSTUFF		

This is a decision on the PETITION UNDER 37 CFR 1.144 FOR WITHDRAWAL OF THE RESTRICTION REQUIREMENT made in the office action mailed August 25, 2004.

On August 25, 2004 a restriction requirement was mailed containing an eight way species restriction. The examiner stated that the claims comprising a generic method utilized with specific foods have created a burdensome search, such that multiple inventions exist. The examiner also stated that claims 70, and 75-79 are generic and listed which claims were directed to each specie(s). Applicant responded on December 24, 2004 and elected Species 5 (oils/fats group).

On December 24, 2004 the instant petition under 37 CFR 1.144 was filed to formally request that the examiner withdraw the restriction requirement.

DECISION

Section 806.04 of the MPEP states in part:

806.04 [R-3] Genus and/or Species Inventions
Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct. However, 37 CFR 1.141 provides that an allowable generic claim may link a reasonable number of species embraced thereby. The practice is set forth in 37 CFR 1.146.

Additionally, Section 803 of the MPEP states:

803 Restriction - When Proper

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application, the examiner identifies 8 patentably distinct species in restriction requirement made August 25, 2004. The species is directed to specific types of "foodstuffs". Applicant argues that because the types of foodstuffs have been examined on several occasions prior to the restriction requirement, the requirement should be withdrawn. It is noted that the claim limitations in question were first presented in the original claims (original claim 38) with few exceptions. These claims were treated on the merits and rejected with art in the office action mailed February 27, 2002. The claim limitations in question were then separated into multiple dependent claims in the response July 29, 2002, and these claims were again examined and rejected with art in the office action mailed October 22, 2002. A subsequent office action mailed May 6, 2003 further treated the claims including the limitations now subject to a species requirement. In the restriction requirement, the examiner alludes to the claimed use of a lipase with various foodstuffs and ingredients would otherwise require a search of the method within a large number of different subclasses, and perhaps multiple classes. The examiner further states that the numerous amendments to the claims during the prosecution of this application to arrive at the current claims have necessitated the requirement.

It is noted that the examiner has not clearly established that any serious burden exists to examine all of the claims. The lack of a burden is further evidenced by the fact that the examiner has previously examined all claims and rejected the claims with the limitations of the new species requirement over the same prior art throughout the prosecution of the application.

Accordingly, because no serious burden of search has been shown to exist by the examiner, the restriction requirement is improper and should be withdrawn. The instant petition is **GRANTED.** The examiner is directed to withdraw the requirement and prepare a new office action including an examination of claims 70-79 on the merits.

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